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APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. 09/467,628 12/20/99 BURKE Т PANVERA.003. **EXAMINER** HM12/0508 MARK K JOHNSON MURPHY. PO BOX 510644 ART UNIT PAPER NUMBER NEW BERLIN WI 53131-0644 1646 **DATE MAILED:** 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

		1
	Application No.	Applicant(s)
Office Action Summary	09/467,628	BURKE ET AL.
	Examiner	Art Unit
	Joseph F Murphy	1646
The MAILING DATE of this communic Period for Reply	cation appears on the cover sheet with	the correspondence address
A SHORTENED STATUTORY PERIOD FOR THE MAILING DATE OF THIS COMMUNI - Extensions of time may be available under the provisions after SIX (6) MONTHS from the mailing date of this comm - If the period for reply specified above is less than thirty (3 - If NO period for reply is specified above, the maximum states to reply the period for reply and the period for reply the period for reply and the period for reply the period for reply and the period for reply the period for reply and the period for reply the period for reply and the period for reply and the period for reply and the period for reply the period for reply and the period for repl	CATION. of 37 CFR 1.136 (a). In no event, however, may a renunication. 0) days, a reply within the statutory minimum of thirty atutory period will apply and will expire SIX (6) MONT will, by statute, cause the application to become ABA	eply be timely filed (30) days will be considered timely. HS from the mailing date of this communication. NDONED (35 U.S.C. § 133).
1) Responsive to communication(s) fil	led on <u>20 December 1999</u> .	·
2a) This action is FINAL .	2b)⊠ This action is non-final.	
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
Disposition of Claims		
4)⊠ Claim(s) <u>1-12</u> is/are pending in the	application.	
4a) Of the above claim(s) is/a	re withdrawn from consideration.	
5) Claim(s) is/are allowed.		
6) Claim(s) is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claims 1-12 are subject to restriction	on and/or election requirement.	
Application Papers	·	
9) The specification is objected to by the	ne Examiner.	
10) The drawing(s) filed on is/are	objected to by the Examiner.	
11) The proposed drawing correction file	ed on is: a) approved b)	disapproved.
12) The oath or declaration is objected to	o by the Examiner.	
Priority under 35 U.S.C. § 119		
13) Acknowledgment is made of a claim	for foreign priority under 35 U.S.C. §	119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:	·	
1. Certified copies of the priority	documents have been received.	
2. Certified copies of the priority	documents have been received in Ap	plication No
	of the priority documents have been relational Bureau (PCT Rule 17.2(a)). In for a list of the certified copies not re	
14) Acknowledgement is made of a clair	•	
Attachment(s)		
 15) Notice of References Cited (PTO-892) 16) Notice of Draftsperson's Patent Drawing Review (17) Information Disclosure Statement(s) (PTO-1449) I 	PTO-948) 19) Notice of I	Summary (PTO-413) Paper No(s) nformal Patent Application (PTO-152) x Cover Sheet .

Application/Control Number: 09/467,628

Art Unit: 1646

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Program for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method for measuring binding activity of molecules to steroid hormone receptors, classified in class 435, subclass 7.8.
- II. Claims 9-12, drawn to a kit for identifying molecules which bind to steroid hormone receptors, classified in class 536, subclass 25.32.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the labeled nucleic acid of invention II can be used as a hybridization probe.

Application/Control Number: 09/467,628

Art Unit: 1646

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Application/Control Number: 09/467,628

Art Unit: 1646

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Joseph F. Murphy, Ph. D.

Patent Examiner

Art Unit 1646

April 26, 2001

PREMA MERTZ
PRIMARY FXAMINER